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SUGHRUE MION, PLLC				
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EXAMINER				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/540,141
Filing Date: August 09, 2005
Appellant(s): EMMER, GERARD

David P. Emery
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/2/09 appealing from the Office action mailed 4/2/08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 22, 24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dusterhoft (US PgPub 2002/0062161). Dusterhoft teaches an apparatus for a free expansion (see Figs. 2 and 7, and paragraph 47). While Dusterhoft does not specifically teach that an injection parameter of the fluid is controlled according to the instant claim 22, Dusterhoft teaches a controllable pressure apparatus (26). The apparatus taught by Dusterhoft is capable of performing the instantly claimed function which, it should be noted, is a method limitation and does not materially affect the apparatus.

(10) Response to Argument

In response to applicant's argument that Dusterhoft does not teach the limitations of instant claims 22, 24 and 28, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The structure taught by Dusterhoft includes a controllable pressure apparatus (26), which is capable of controlling an injection parameter of the fluid so that the final internal volume of the container falls within predetermined limits with respect to a reference volume. Additionally, this function is a method limitation and does not materially affect the apparatus.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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